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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,359	09/27/2001	Paul Kenneth Whittingham	13347US01	6427

7590

03/31/2005

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EXAMINER
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RONES, CHARLES

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/965,359

**Applicant(s)**

WHITTINGHAM ET AL.

**Examiner**

Charles Rones

**Art Unit**

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Amendment***

The amendment timely filed on December 24, 2004.

### ***Allowable Subject Matter***

Claims 14-50 are allowed.

Claims 52-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 52, 54, and 57-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Iprint.com, Inc. WIPO Publication WO/01/66349, applicant's admitted prior art ('Iprint').

As to claim 52, Iprint discloses:

a database (25); and  
at least one server receiving orders for labels via the internet, the orders identifying variable data to be printed on the labels and storing the orders in the database, at least one server being responsive to a user's input to process a plurality of orders together to form a printing job to be produced on an identified machine type and automatically generating a production data file for the printings to be produced for the job, the at least one server thereafter storing the production data file in the database, and sending a stored production data file to a remote location via the Internet wherein labels are deemed to be any product information printed on a product as stated in applicant's specification on page 8; See pages 8, lines 5-28 (8:5-28); 9:1-10; 12:1-10.

As to claim 54, the modified invention of Iprint discloses,

wherein different types of production data files are generated for different types of machines used in the production of labels; See 9:1-10.

As to claim 57, Iprint discloses,

wherein the system includes a main server and a web server that forms an interface between the main server and Internet; See Fig. 1; 4:14-28.

As to claim 58, Iprint discloses,

wherein the system includes a main server and a second server; See Fig. 1; 4:14-28;  
the second server being responsive to job data received from the main server to  
generate the production data file; See Fig. 1; 4:14-28.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Alternatively, claims 52 and 54-58 are rejected under 35 U.S.C. 103(a) as being  
unpatentable over Iprint.com, Inc. WIPO Publication WO/01/66349, applicant's admitted  
prior art ('Iprint').

As to claim 52, Iprint discloses:

a database (25); and  
at least one server receiving orders for printing via the internet, the orders  
identifying variable data to be printed on the print medium and storing the orders in the  
database, at least one server being responsive to a user's input to process a plurality of  
orders together to form a printing job to be produced on an identified machine type and

Art Unit: 2164

automatically generating a production data file for the printings to be produced for the job, the at least one server thereafter storing the production data file in the database, and sending a stored production data file to a remote location via the Internet; See pages 8, lines 5-28 (8:5-28); 9:1-10; 12:1-10.

Iprint discloses the claimed invention except for using labels to print. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use labels to print since it was known in the art that using business cards and stationery would need to print labels of address information to mail letters to a large number of customers to generate business.

As to claim 54, the modified invention of Iprint discloses,

wherein different types of production data files are generated for different types of machines used in the production of labels; See 9:1-10; 18:4-10.

As to claims 54-56,

Iprint discloses the claimed invention except for wherein production data files are generated for thermal printers; wherein production data files are generated for plate making machines. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for wherein production data files are generated for thermal printers; wherein production data files are generated for plate making machines since it was known in the art that each printer requires a certain

Art Unit: 2164

interface and programming which a file must be prepared to interface with that particular printer and that thermal printers are a common printer used to print which would provide for a large amount of customers on such a widely used type of printer; lithographic plate printing is widely used for printing the same image over and over again in a proven method of reproducing images; See 7:20-25.

As to claim 57, Iprint discloses,

wherein the system includes a main server and a web server that forms an interface between the main server and the Internet; See Fig. 1; 4:14-28; 13:20-26.

As to claim 58, Iprint discloses,


wherein the system includes a main server and a second server; See Fig. 1; 4:14-28; the second server being responsive to job data received from the main server to generate the production data file; See Fig. 1; 4:14-28.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Rones whose telephone number is 571-272-4085. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charles Rones  
Primary Examiner  
Art Unit 2164

March 29, 2005